

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 26, 2006. In the Office Action, Claims 1-14 are pending and stand rejected. Applicants amend Claims 1 and 8. Applicants respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Office Action rejects Claims 1-14 under 35 U.S.C. §103(a) as being unpatenable over U.S. Patent Application Publication No. 2004/0002955 A1 of Gadbois et al. ("*Gadbois*") in view of U.S. Patent Application Publication No. 2004/0039738 of Cutlip ("*Cutlip*"). Applicants respectfully request reconsideration and allowance of Claims 1-14 for the reasons discussed below.

Claims 21-23, 25-27, and 30 are Allowable Over the Cited References

First, Applicants respectfully submit that the proposed *Gadbois-Cutlip* combination does not disclose, teach or suggest each and every element recited in Applicants' claims. For example, the proposed *Gadbois-Cutlip* combination does not disclose, teach, or suggest "arranging User object(s) under a repository layer comprising one or more Repository objects collectively forming a Prefix, each User object representing a Web Services account," as recited in amended Claim 1. Rather, *Gadbois* merely discloses that a root node "is maintained by the host system . . . and is represented by a Host node 210." (Page 2, paragraph 27). "A first tier or set of interior nodes coupled to the host node include a set of nodes representative of organizations." (Page 3, paragraph 27). Applicants assume from the Examiner's reliance on Figure 2 and the accompanying description that the Examiner considers the host node 210 of *Gadbois* as being analogous to Applicants' recited User object(s) and the organizational nodes 222 and 224 of *Gadbois* as being analogous to Applicants' recited Business Entity object(s). Even if the host node 210 of *Gadbois* is considered to be analogous to Applicants' recited "User object(s)" (which Applicants do not admit), Applicants submit that since the topmost level of the hierarchy of *Gadbois* includes a host node 210, *Gadbois* cannot be said to disclose, teach, or suggest "arranging User object(s) under a repository layer comprising one or more Repository objects collectively forming a

Prefix,” as recited in amended Claim 1. Furthermore, there is no disclosure in *Gadbois* that the host node 210 includes a “User object representing a Web Services account,” as also recited in amended Claim 1.

The additional disclosure of *Cutlip* does not cure the deficiencies of *Gadbois* identified above. To the contrary, *Cutlip* merely discloses “businessEntity”, “businessService”, “bindingTemplate”, and “tModel” data type structures. “A particular businessEntity instance may offer (i.e., publish) a number of business services in the registry, where each service is identified using an instance of the businessService data type 210.” (Page 3, paragraph 40). “Each businessService instance [210] has an instance of bindingTemplate data type 220” and that “[a]n instance of bindingTemplate may reference on or more instances of tModel data type 230.” (Page 3, paragraph 41). Thus, the topmost level of the hierarchical arrangement illustrated in Figure 2 of *Cutlip* is the BusinessEntity data structure. There is no disclosure in *Cutlip* of “arranging User object(s) under a repository layer comprising one or more Repository objects collectively forming a Prefix, each User object representing a Web Services account,” as recited in amended Claim 1.

For at least these reasons, Applicants request reconsideration and allowance of Claim 1, together with Claims 2-7 that depend from Claim 1.

Similar to Claim 1, Claim 8 includes a limitation regarding “arranging User object(s) under a repository layer comprising one or more Repository objects collectively forming a Prefix, each User object representing a Web Services account.” Therefore, for similar reasons discussed above with regard to Claim 1, Applicants respectfully contend that Claim 8 is patentably distinguishable from the proposed *Gadbois-Cutlip* combination.

For at least these reasons, Applicants request reconsideration and allowance of Claim 8, together with Claims 9-14 that depend from Claim 8.

The Proposed Combinations of References are Improper

Second, Applicants respectfully submit that the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the

knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine *Gadbois* with *Cutlip* in the manner suggested by the Examiner. Applicants' claims are allowable for at least this additional reason.

1. The Legal Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Gadbois-Cutlip* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Applicants respectfully submit that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicants' claims as a blueprint, in an attempt to reconstruct Applicants' claims.

The governing Federal Circuit case law makes this strict legal standard clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* ***Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."*** *In re Mills*, 916 F.2d at 682,

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine***); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “***The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.***” M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome ***wherein that which only the invention taught is used against its teacher.***” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, ***explaining that the required evidence of***

such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is ***rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references***. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

2. The Analysis

As the basis for the proposed *Gadbois-Cutlip* combination, the Examiner states that “[i]t would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified *Gadbois* by teaching of *Cutlip* because arranging corresponding tModel object(s) under at least one of user object(s), repository object, and prefix would enable tModel type data to be used to point to technical definitions (i.e., interface specifications) for a registered service, thus serving as “technical fingerprints” to identify services (Cutlip, paragraph 41).

It appears that the Examiner has merely proposed alleged advantages of combining *Gadbois* with *Cutlip* (advantages which Applicants do not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has cited a portions of *Cutlip* that touts an advantage of its respective system, the Examiner has not pointed to any portions of the cited references that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the tModel relationships disclosed in *Cutlip* into the hierarchical structure disclosed in *Gadbois*. In other words, the alleged advantage of the system disclosed in *Cutlip* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention (***without using Applicants' claims as a guide***) to modify the particular techniques disclosed in *Gadbois* with the cited disclosure of *Cutlip* ; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so

would purportedly meet the limitations of Applicants' claims. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

Applicants respectfully submit that the Examiner's attempt to modify or combine *Gadbois* with *Cutlip* appears to constitute the type of impermissible hindsight reconstruction of Applicants' claims, using Applicants' claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases. Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Gadbois* with *Cutlip* in the manner the Examiner proposes, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicants respectfully submit that the rejection must therefore be withdrawn.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Applicants' claims.

CONCLUSION

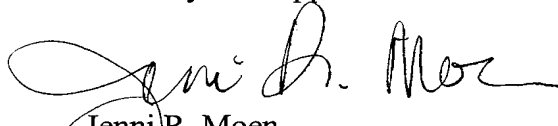
Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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